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EXAMINER

DESAI, RACHNA SINGH

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BAO TRAN

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Appeal 2009-001740  
Application 10/764,647<sup>1</sup>  
Technology Center 2100

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Decided: February 2, 2010

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*Before* JAY P. LUCAS, JOHN A. JEFFERY, and THU A. DANG,  
*Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

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<sup>1</sup> Application filed January 26, 2004. The real party in interest is the inventor and attorney of record, Bao Tran.

### STATEMENT OF THE CASE

Appellant appeals from a final rejection of claims 1 to 21 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant's invention relates to an electronic document containing internal and external links. (*See* claim 1.) In some embodiments, the electronic document is a portable document format (PDF) electronic file of either a patent or patent application. (*See* Spec. 6, bottom; Spec. 14, bottom.) Internal links in the claims section (Appellant's "third portion") (claim 1) refer to a word or phrase in the written description section (Appellant's "second portion") (claim 1). (*See* claim 6; Spec. 8, middle.) External links in the prior art section (Appellant's "first portion") access external documents. (*See* claim 6; Spec. 8, top.) In the words of Appellant:

The annotated document is easier to interpret since relevant information is parsed and visually provided to the user. Further, external information such as information from external documents and file history can be incorporated to ease interpretation.

(Spec. 4, top).

Claim 1 and claim 6 are exemplary, and are reproduced below:

1. A method for providing an electronic document having first, second and third portions, comprising:

embedding one or more links in the first portion referencing one or more external documents viewable using a viewer application;

embedding one or more links in the third portion referencing information contained in the second portion.

6. The method of claim 1, wherein the electronic document comprises a patent or a patent application and wherein the first portion comprises a prior art section, the second portion comprises a description section, and the third portion comprises a claim section, comprising cross-referencing an element in the claim section against one or more references to the element in the specification section.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Mahoney	US 5,999,664	Dec. 07, 1999
Gonzales	US 2002/0161603 A1	Oct. 31, 2002
Sweet	US 6,567,799 B2	May 20, 2003
Fogel	US 2004/0059994 A1	Mar. 25, 2004 (filed Dec. 02, 2002)
Barger	US 2004/0205542 A1	Oct. 14, 2004 (filed Sep. 07, 2001)

## REJECTIONS

The Examiner rejects the claims as follows:

R1: Claim 15 stands rejected under 35 U.S.C. § 112, 1st paragraph, as failing to comply with the written description requirement.

- R2: Claims 1 to 7, 10 to 15,<sup>2</sup> and 19 to 21 stand rejected under 35 U.S.C. § 103(a) for being obvious over Gonzales in view of Sweet.
- R3: Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) for being obvious over Gonzales in view of Sweet and Fogel.
- R4: Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) for being obvious over Gonzales in view of Sweet and Mahoney.
- R5: Claim 18 stands rejected under 35 U.S.C. § 103(a) for being obvious over Gonzales in view of Sweet and Bargerion.

Appellant contends that the claimed subject matter is not rendered obvious by Gonzales in combination with Sweet or Fogel, Mahoney, or Bargerion because none of the references discloses Appellant's claim limitations "embedding one or more links in the first portion referencing one or more external documents viewable using a viewer application" and "embedding one or more links in the third portion referencing information contained in the second portion," as recited in claim 1 (Brief 6, bottom). The Examiner contends that each of the claims is properly rejected (Ans. 31, top).

The rejections will be reviewed in the order argued by Appellant. The claims are grouped as per Appellant's Brief. Only those arguments actually made by Appellant have been considered in this opinion. Arguments that

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<sup>2</sup> Although the Examiner omits claim 11 in the statement of the rejection, the Examiner nevertheless includes claim 11 in the corresponding text of the rejection. *Compare* Ans. 5 *with* Ans. 11. Accordingly, we presume that the Examiner intended to include claim 11 in this rejection.

Appellant could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue specifically turns on whether the Gonzales and Sweet references disclose an electronic document with internal and external links.

### FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

#### *Disclosure*

1. Appellant has invented a method, apparatus, and system that include an electronic document with internal links to document sections and external links to other files. (*See* claims 1, 19, and 20.)

#### *Sweet*

2. The Sweet reference discloses an electronic document with internal links and external links to other files. (*See* col. 8, ll. 41-44; col. 10, ll. 7-8 and 31-32.)

#### *Gonzales*

3. The Gonzales reference discloses a web page with external links. (*See* ¶ [0047] at l. 4; Fig. 2.)

*Fogel*

4. The Fogel reference discloses a patent claim tree view in an electronic file. (See ¶ [0229] at 1. 1.)

*Mahoney*

5. The Mahoney reference discloses optical character recognition (OCR) techniques. (See col. 3, ll. 4-10 and 13-16.)

*Barger*

6. The Barger reference discloses saving user annotations in an electronic document. (See ¶¶ [0004] and [0005].)

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006)

In sustaining a multiple reference rejection under 35 U.S.C. § 103(a), the Board may rely on one reference alone without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458 n.2 (CCPA 1966).

Our guiding court has held “[t]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claims in the ’198 application.” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

“A court must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 401 (2007).

### ANALYSIS

From our review of the administrative record, we find that the Examiner presents his evidence for supporting a conclusion of obviousness on pages 2 to 15 of the Examiner’s Answer. In opposition, Appellant presents a number of arguments.

*Argument with respect to the rejection  
of claim 15 under 35 U.S.C. § 112, 1<sup>st</sup> paragraph [R1]*

Dependent claim 15 recites, in relevant part, “mapping intellectual property for an industry covered by the patent or patent application.”

Appellant makes no arguments in response to the Examiner’s rejection [R1] under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, as failing to comply with the written description requirement. (*See* Brief 4, top to 16, bottom.) The Examiner finds that the Specification includes no description of the claim language (Ans. 2, bottom). Since Appellant presents no argument in response to the Examiner’s finding (*id.*), we summarily sustain the rejection [R1]. *See* MPEP § 1205.02 (“If a ground of rejection stated by the examiner is not addressed in the appellant’s brief, that ground of rejection will be summarily sustained by the Board.”).



*Arguments with respect to the rejection  
of claims 1 to 7, 10 to 15, and 19 to 21  
under 35 U.S.C. § 103(a) [R2]*

Appellant argues that the claimed “embedding one or more links in the first portion referencing one or more external documents viewable using a viewer application” and “embedding one or more links in the third portion referencing information contained in the second portion,” as recited in claim 1 are not disclosed in Gonzales and Sweet (Brief 6, bottom).

The Examiner finds that Gonzales discloses a web page that includes external links.

We select claim 1 as representative of the grouping. While we appreciate the Examiner’s findings regarding Gonzales, we focus on Sweet for the operative claim elements. (*See In re Bush* and *In re Boyer*, cited above.)

We carefully considered the Brief, the Answer, the cited portions of the Gonzales and Sweet, and indeed the entire references. We find that the Sweet reference discloses an electronic document with internal links and external links to other files (FF#2). In comparison, Appellant has invented a method that includes an electronic document with internal links to document sections and external links to other files (FF#1). Sweet teaches: “The PDF document which is displayed by the PDF viewer may have hypertext links to web pages, as well as to internal pages within the PDF document.” (Col. 8, ll. 42-44). First, Sweet’s internal “links to ... internal pages within the PDF document” (col. 8, l. 43-44) are no different from the “internal links,” as claimed. Second, Appellant’s “external links” read on Sweet’s “hypertext links to web pages” (col. 8, l. 43). Moreover, we find that a person of

ordinary skill in the art would have recognized Appellant's claimed "viewer application" as being commensurate with Sweet's PDF viewer (col. 8, l. 46). Finally, we note that the Examiner's findings regarding Gonzales are cumulative prior art, in that Gonzales discloses at least "external links" (FF#3), as recited in claim 1. Accordingly, we find no error in the analysis of claim 1 in this regard.

Appellant further argues that the combination of Sweet and Gonzales is non-functional and impracticable for its intended purposes (*see* Brief 7, bottom); the desirability of the combination is not suggested (*see* Brief 8, top); there is no reasonable expectation of success (*see* Brief 8, middle); the Examiner simply ignores claim limitations as merely written text on a printed page (*see* Ans.10, bottom); and the references do not show cross-referencing the element in the claim section with various documents, as recited in any of claims 7, 10, 11, 12, 14, 15, and 19 to 21. (*See* Brief 11, top to bottom.)

In view of our analysis of Sweet's teachings (*see supra*) and the "Response to Arguments" section of the Examiner's Answer (*see* 15, middle to 27, middle), we regard Appellant's arguments as having been successfully addressed. Accordingly, we find no error regarding the claims rejected under [R1].

*Argument with respect to the rejection  
of claims 8 and 9  
under 35 U.S.C. § 103(a) [R3]*

Claim 8 depends from exemplary claim 6 (*supra*). Claim 8 recites, in relevant part, "visualizing one or more claims in a tree view."

Appellant argues there is no teaching or suggestion of a “tree view” (claim 8).

In reply, the Examiner points out that the Fogel reference teaches a method of checking the semantics and syntax of patent claims in a claim tree format. (*See* Ans. 13, middle.)

In this case, we agree with the Examiner that Fogel teaches a “tree view,” as claimed. We note that Appellant’s opening Brief presents no convincing argument explaining, with any degree of specificity, how or why Fogel’s disclosure fails to meet the claim limitation “tree view,” as recited in dependent claim 8. We find that the Fogel reference does indeed disclose a patent claim tree view in an electronic file (FF#4). We find that a person of ordinary skill in the art would have recognized Fogel’s disclosure as being the same as the claimed “tree view” (claim 8). Accordingly, we find no error.

*Argument with respect to the rejection  
of claims 16 and 17  
under 35 U.S.C. § 103(a) [R4]*

Claim 16 depends from exemplary claim 1. Claim 16 recites, in relevant part, “generating text using optical character recognition (OCR) from an image of a page of the document and associating the text with the corresponding location of the text in the image.”

Appellant argues that the Mahoney reference teaches away from generating text using OCR scanning capabilities (Brief 15, top).

In reply, the Examiner points out that the Mahoney reference discloses that OCR techniques were well-known in the art. (*See* Ans. 29, middle.)

Appellant has raised the issue of the Mahoney reference teaching away from the claimed invention. Our guiding court has held “[t]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claims in the ’198 application.” (*In re Fulton*, cited above).

In this case, we regard Mahoney’s disclosure of OCR techniques (FF#5) as merely an alternative to other disclosed techniques. That Mahoney refers to two or more methods of generating text is a mere matter of preferences or alternatives, and not a teaching away that renders the claim unobvious. A teaching away requires denigration of one method over another. That is not the case in Mahoney, where the patent discloses that “visual representations of scanned documents” (*see* col. 5, l. 27) when used in conjunction with an OCR program (*id.* at l. 25) provide an improvement over the use of OCR alone. (*See* “Background of the Invention,” col. 3, ll. 17-20 and 30-32.) In view of the teachings of *In re Fulton* and our analysis of Mahoney’s improvement over the prior art, we find unconvincing Appellant’s argument that Mahoney teaches away from the claimed invention. Accordingly, we find no error in the Examiner’s analysis of claim 16.

*Argument with respect to the rejection  
of claim 18  
under 35 U.S.C. § 103(a) [R5]*

Claim 18 depends from exemplary claim 1 and recites, in relevant part, “saving user annotation in the document.”

Appellant argues that in the absence of the Examiner’s use of impermissible hindsight, there would have been no motivation to combine the references (Brief 16, middle).

In reply, the Examiner points out in the Answer that it would have been obvious to a person of ordinary skill in the art to incorporate Barger’s annotation scheme in the system of Gonzales/Sweet to provide a means for preserving an annotation in digital form for easy retrieval and frequent amendment (Ans. 29, bottom to 30, top).

“A court must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions.” *KSR Int’l Co. v. Teleflex, Inc.*, cited above.

We agree with the Examiner. We find that the Barger reference discloses saving user annotations in an electronic document (FF#6). We regard the annotation element of claim 18 as a well-known prior art element. Since the annotation element is used in a predictable fashion and according to its established function, we are unconvinced by Appellant’s argument that there would have been no motivation to combine the references absent the Examiner’s impermissible hindsight bias. In light of the teachings of *KSR* and the Examiner’s stated rationale, we find no error in the Examiner’s analysis.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 21.

DECISION

The Examiner's rejections [R1 to R5] of claims 1 to 21 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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